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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/264,762	03/09/1999	RICHARD N. JURMAIN	BT10	3685

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SHERRILL LAW OFFICES
4756 BANNING AVE
SUITE 212
WHITE BEAR LAKE, MN 55110-3205

EXAMINER

SOTOMAYOR, JOHN

ART UNIT	PAPER NUMBER
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3714

DATE MAILED: 05/23/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/264,762

Applicant(s)

JURMAIN, RICHARD N.

Examiner

John L Sotomayor

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 March 1999.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-42 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-42 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2,4,5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION***Drawings***

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: The Bellows Switch cited as reference number 161 in the specification does not appear in the drawings. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Specification

1. Applicant is reminded of the proper language and format for an abstract of the disclosure.
2. The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.
3. The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 26 and 27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicant's use of the phrase "at least some" in these claims renders the claims indefinite.

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6. Claim 31 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The phrasing of this claim wherein a “container normally used in commerce” opens the claim to any container fails to place any limit on the container to be used. The second phrase “as a container of a product consumed by a user of the device” fails to limit as well, but also fails to particularly point out or distinctly claim invention subject matter thus rendering the claim indefinite.

7. Claim 35 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. This claim is dependant upon a voice recognition feature set forth in claim 34, however, applicant fails to point out or distinctly claim how a personality may be inferred from a sound sample captured by the voice recognition circuit, thus rendering the claim indefinite.

8. Claims 36 and 37 rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential structural cooperative relationships of elements, such omission amounting to a gap between the necessary structural connections. See MPEP § 2172.01. The omitted structural cooperative relationships are: Claims 36 and 37 are dependent upon claim 32 as written. However, claim 32 is directed toward an entertainment device, and claims 36 and 37 are directed toward a portable personality simulator, thus omitting necessary structural connections between the claims. It is the examiner’s opinion that the claims were originally intended to be dependant upon claim 33 and that the dependence upon claim 32 is possibly a typographical error. The claims are examined in that light.

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9. Claim 39 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The phrase “sounds occurring in an environment responsive to commands issued by the simulator” renders confusion about what the claim is attempting to point out, thus rendering the claim indefinite.

10. Claim 40 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The sounds listed in the claim are not indicative of personalities, rendering confusion about the claim. Claim 40 is also dependant upon claim 39, and inherits the deficiencies of that claim, rendering the claim indefinite.

Claim Rejections - 35 USC § 102

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

12. Claims 1,2,4 are rejected under 35 U.S.C. 102(b) as being anticipated by Bonnett (US 4,138,722).

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13. Regarding claim 1, Bonnett discloses a device comprising an enclosure with an integral electronic circuit, an actuator connected to the electronic circuit, and a pushbutton switch responsive to the simulation of an addictive activity by the user (Figure 1 and Figure 2).

14. Regarding claim 2, Bonnett discloses an alphanumeric display connected to the electronic circuit and mounted in the simulator case, observable by the user of the device, and responsive to actuations of the pushbutton switch (Figure 1 and Col 2, lines 38-48).

15. Regarding claim 4, Bonnett discloses a breathing tube with an integral switch that serves as a one-way bellows type switch as the user breathes into the tube (Col 3, lines 1-7).

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

16. Claims 22-24 and are rejected under 35 U.S.C. 102 (a) as being anticipated by Schneier et al (US 5,871,398).

17. Regarding claim 22, Schneier et al discloses a handheld gaming device with a case, power source, programmable electronic circuit, programmable sound synthesizer, and communications port (Fig. 5).

18. Regarding claim 23, Schneier et al discloses a handheld gaming device with an integral visual display connected to the integral electronic circuit and used for issuing visual prompts to the user (Fig. 5).

19. Regarding claim 24, Schneier et al discloses a handheld gaming device with a microphone integrally connected to the internal electronic circuit to detect sounds produced by the user (Fig. 5).

Claim Rejections - 35 USC § 103

20. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

21. Claims 3,6,8-11 and 42 rejected under 35 U.S.C. 103(a) as being unpatentable over Bonnett in view of Schneier et al (US 5,871,398).

22. Regarding claims 3,30 and 42, Bonnett discloses a handheld simulator device, but does not disclose that the handheld device has an integral slot that may be used for the insertion and detection of payment means. Schneier et al teaches a handheld device used as a gaming simulator that has an integral slot into which payment means, in the form of a smart card containing credits, may be inserted and sensed by the device for the purchase of a product to be consumed by the user (Figure 4 and Col 12, lines 32-35). The insertion of the payment means is in response to prompts from the handheld device when purchasing games (Col 14, lines 55-60). The smart card is a PCMCIA adapted device and is a common and well-understood means for transferring information into handheld devices, including payment means. Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to provide an integral PCMCIA slot for the insertion and detection of payment means by the handheld device.

23. Regarding claim 6, Bonnett discloses a switch that is responsive to user actions in using the device, however, Bonnett does not disclose a microphone in the handheld device. Schneier et al teaches a microphone that may be used to detect sounds from the user in response to user

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requests (Col 14, line 19 and Fig. 5). Each method is utilized as a means for responding to user actions when using the device. Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to provide a microphone integral to the device to respond to user requests.

24. Regarding claims 8-10, Bonnett discloses a switch that is responsive to user actions in using the device, however, Bonnett does not disclose a speech recognition circuit in the handheld device. Schneier et al teaches a voice activated sound recognition circuit that may be used to detect sounds from the user in response to user requests (Col 14, line 22 and Fig. 5). Each method is utilized as a means for responding to user actions when using the device. Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to provide a speech recognition circuit integral to the device capable of recognizing sounds to respond to user actions.

25. Regarding claim 11, Bonnett discloses a handheld device used to measure user interaction and provide this information to the user (Col 1, lines 55-61). However, Bonnett does not disclose that this interaction with the user is through speech. Schneier et al teaches a handheld device with a speech synthesizer connected to a speaker for communicating messages to the user (Col 13, lines 38-47). Both devices require a method of informing the user as to outcomes of user interaction with the device. Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to provide a speech synthesizer electrically connected to the circuit in the handheld device as a means of providing informational messages to the user.

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26. Claims 12-13, 15-16 and 19-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bonnett in view of Brown (US 5,918,603).

27. Regarding claim 12, Bonnett discloses a handheld simulator with a case and an electronic circuit housed within the case. Bonnett does not specifically disclose that a speaker is connected to the electronic circuit. Brown teaches a hand held simulator with a speaker attached to the electronic circuit to provide sounds to direct the user to perform actions (Col 4, lines 5-7). Both the simulator discloses by Bonnett and the simulator taught by Brown present an embodiment of the simulator used to treat medical conditions, including inhibiting smoking behavior.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to provide a speaker to produce sounds and instructions consistent with the inhibition of smoking behavior.

28. Regarding claim 13, Bonnett discloses a handheld simulator with a case and an electronic circuit housed within the case. Bonnett does not specifically disclose that a sensor is connected to the electronic circuit. Brown teaches that the simulator may be equipped with a monitoring sensor, used to monitor user response (Col 3, lines 14-22). Both the simulator discloses by Bonnett and the simulator taught by Brown present an embodiment of the simulator used to treat medical conditions, including inhibiting smoking behavior. Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to provide a means to monitor the effectiveness of treatment by providing a sensor to monitor user responses to treatment that includes sounds emitted from the integral speaker.

29. Regarding claim 15, Bonnett discloses a portable simulator with an integral recess in the case adapted to secure an accessory used in association with the simulator (Fig. 1).

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30. Regarding claim 16, Bonnett discloses a portable simulator with an integral sensor accessory that produces a signal when activated that is subsequently processed by the electronic circuit of the simulator. Bonnett does not disclose that this sensor may be a hypodermic style sensor. However, Brown teaches a handheld simulator that has a plurality of sensor devices that may be attached for measuring physical parameter, for example, blood glucose levels for a diabetic (Col 3, lines 14-19). It is a common and well-known practice for diabetics to utilize a hypodermic as the introduction method for insulin. Therefore, it would have been obvious to one of ordinary skill in the art to style a monitoring sensor as a hypodermic simulation device with a signal that is processed by the electronic circuit when the sensor is activated.

31. Regarding claim 19, Bonnett discloses a portable simulator with a visual display connected to the electronic circuit and used for issuing messages to the user (Fig. 1).

32. Regarding claims 20 and 21, Bonnett discloses a portable simulator with an orifice in the case and an integral breathing apparatus permitting the introduction of outside air into the case and allowing the user to exhale into the interior region of the case (Col 2, lines 63-68).

33. Claims 14,17,18,25-26, 29,32,33, and 35-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bonnett in view of Brown in further view of Schneier et al.

34. Regarding claim 14, Bonnett discloses a handheld simulator with an input device for gathering user input. Brown teaches that the input device may be a sensor used to gather user input. Schneier et al teaches that the sensor may comprise a microphone used to detect sound made by the user. Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to provide the handheld simulator with a microphone used to detect sounds made by the user.

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35. Regarding claim 17, Bonnett discloses a handheld simulator with an orifice formed within the case, but does not disclose that the handheld device has an integral slot that may be used for the insertion and detection of payment means. Schneier et al teaches a handheld device used as a gaming simulator that has an integral slot into which payment means, in the form of a smart card containing credits, may be inserted and sensed by the device for the purchase of a product to be consumed by the user (Figure 4 and Col 12, lines 32-35). The insertion of the payment means is in response to prompts from the handheld device when purchasing games (Col 14, lines 55-60). The smart card is a PCMCIA adapted device and is a common and well-understood means for transferring information into handheld devices, including payment means. Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to provide an integral PCMCIA slot for the insertion and detection of payment means by the handheld device.

36. Regarding claims 18 and 33, Bonnett discloses a handheld simulator with an electronic circuit, but does not disclose a speech synthesizer. Schneier et al teaches a handheld device with a speech synthesizer connected to a speaker for communicating messages to the user (Col 13, lines 38-47). Both devices require a method of informing the user as to outcomes of user interaction with the device. Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to provide a speech synthesizer electrically connected to the circuit in the handheld device as a means of providing informational messages to the user.

37. Regarding claim 25, Bonnett discloses a portable simulation devices that has a bore passing through the surface of the case, a tube connected to the bore, a vent perforation allowing the passage of exhaled air, and a flow restrictor to restrict direction and volume of the air passing

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into the case (Fig. 1, and Col 2, lines 63-68). Bonnett does not specifically disclose that the simulation device can be used for entertainment. However, Schneier et al teaches a handheld gambling simulation device may be used for entertainment of the user (Col 4, lines 47-64). Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to provide a portable smoking simulation device as a means entertainment for the user.

38. Regarding claim 26, Bonnett does not specifically disclose that the handheld device has a memory for storage of user information. However, Schneier et al teaches that the handheld device may have a memory circuit integral to the device (Col 14, lines 55-60). Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to provide an integral memory circuit for user informational purposes.

39. Regarding claim 29, Bonnett does not disclose a handheld simulator that is specifically used for other addictive behaviors besides smoking. However, Brown teaches a handheld simulator that may be used to treat a plurality of addictive behaviors, with each pattern implemented in software and selectable by the user (Col 3, lines 1-11, and Col 5, lines 38-44). Brown also teaches that treatment of addictive behaviors through the use of software games and simulations has been shown effective (Col 2, lines 52-67). Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to provide user selectable software modules for a plurality of addictive behaviors.

40. Regarding claim 32, Bonnett does not disclose that the memory of the handheld simulator contains any addictive behavior other than ingestion of the product. However, Brown teaches that a treatment simulator will contain a plurality of addictive behaviors in memory for use when required to assist a patient (Col 5, lines 35-50). A common and well-known behavior of the

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users of a particular product is the borrowing of product by a user who has depleted their own supply. Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to provide a software implementation of borrowing behavior through the available communication port from one simulator to another.

41. Regarding claim 34, Bonnett discloses a switch that is responsive to user actions in using the device, however, Bonnett does not disclose a microphone or a speech recognition circuit in the handheld device. Schneier et al teaches a microphone with a voice activated sound recognition circuit that may be used to detect sounds from the user in response to user requests (Col 14, line 22 and Fig. 5). Each method is utilized as a means for responding to user actions when using the device. Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to provide a speech recognition circuit integral to the device capable of recognizing sounds to respond to user actions.

42. Regarding claims 35-36, Bonnett does not disclose that personality traits are available in the software instructions for treating users of the handheld simulator. However, Brown teaches that a plurality of psychological strategies may be implemented in software for the treatment of users of the system (Col 5, lines 35-57). Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to provide a simulation of a personality type, including a celebrity personality, as a psychological strategy to assist in the treatment of addictive behavior.

43. Regarding claims 37-40, Bonnett does not disclose a voice recognition circuit capable of discerning sounds or the volume of those sounds. However, Schneier et al teaches that to assist the handheld simulator in responding to user requests an integral speech recognition circuit is

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necessary (Fig. 5). It is a common and well-known practice to program a speech recognition circuit for a plurality of sounds, such as spoken words, coughs, and sneezing in order to discern activation sound patterns that are not speech. A speech recognition circuit could, therefore, be programmed to recognize a number of bodily and ambient sounds and to provide functionality based upon the sound captured and recognized. Therefore, it would have been obvious to one of ordinary skill in the art to program a handheld simulator's speech recognition software with the profiles, and volume parameters, for a plurality of bodily sounds such as coughs and sneezing, as well as ambient sounds such as the striking of a match.

44. Regarding claim 41, Bonnett discloses a video display that reports the users progress visually to the user, however, Bonnett does not disclose a recording function that is reportable to persons other than the user. However, Brown teaches that a handheld simulator may have a communication line over which the simulator can be monitored and can report the user's usage information to persons at another location (Col 6, lines 33-40). This capability allows improved monitoring of the users condition and compliance when using the handheld device. Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to extend the reporting function across a communication line to report usage information to other persons at a different location from the user.

45. Claims 27-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bonnett in view of Hillsman (US 4,984,158).

46. Regarding claims 27 and 28, Bonnett does not specifically disclose that auditory messages providing instruction to the user are available from the device. However, Hillsman teaches that a portable device to assist a user in performing a simulation of smoking may include

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a speaker with auditory messages designed to inform the user as to the desired and real time performance expected (Col 2, lines 52-53). These desired performance messages may contain messages concerning cigarette consumption as well as others to acquaint the user with physiological information of concern to the user. Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to provide auditory messages informing the user of cigarette consumption and physiological information related to the user's life expectancy in terms of cigarette consumption.

47. Claim 31 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bonnett in view of Drouin (US 4,862,431). Bonnett does not disclose that the handheld device has a case formed to resemble the common container of a commercially available product. However, Drouin teaches that in order to simulate the behavior patterns effectively a case formed like the commercially available product is warranted (Fig 1). Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to provide a case in the shape of a commercially available product to increase the effectiveness of the simulator.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Lucero (US 6,247,643) for a discussion of a portable entertainment device with integral payment means.

Lutz (US 5,908,301) for a discussion of a portable device with video display used in behavior modification.

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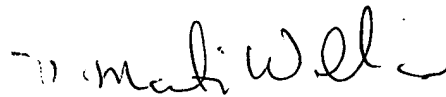
Any inquiry concerning this communication or earlier communications from the examiner should be directed to John L Sotomayor whose telephone number is 703-305-4558.

The examiner can normally be reached on 7:30-4:00 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jessica Harrison can be reached on 703-308-2217. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-7768 for regular communications and 703-308-7768 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-4119.

jls
May 20, 2002



VALENCIA MARTIN-WALLACE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700

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